



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,973	10/07/2003	Wayne P. Young	115.0024-00000	6060

22882 7590 04/04/2005

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT PAPER NUMBER

3739

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/680,973	Applicant(s) YOUNG ET AL.	
	Examiner Matthew J Kasztejna	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8-13 and 20-22 is/are rejected.
- 7) ☒ Claim(s) 3-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) ☒ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/7/03</u> . | 6) ☐ Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group 1, claims 1-13 and 20-22, in the reply filed on March 1, 2005 is acknowledged. Claims 14-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 1, 2005.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: cone 216', seals 222 and 224, leading end 304, trailing end 306 and lumen 308. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2, 8-10 and 20-22 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S Patent No. 6,800,084 to Davison et al.

In regards to claims 1 and 20-22, Davison et al. disclose an instrument comprising: a body 12 having a leading end, a trailing end, and a lumen 16 between the leading and trailing ends; a mid-longitudinal axis passing through the lumen of the body; a dilator 40 at the leading end of the body being movable between an unexpanded position and an expanded position (see Figs. 1 and 2), the dilator having a single leaf 42 adapted to be rolled at least in part around the mid-longitudinal axis of the extractor; and a guide surface 80 configured to engage an instrument 112 inserted through the lumen, the guide surface being adapted to move at least a portion of the dilator away from the mid-longitudinal axis of the extractor upon engagement with the instrument (see Col. 4, Lines 47-67). The apparatus of Davison et al. is inherently capable of the recited method steps (see Col. 5, Lines 1-14).

In regards to claim 2, Davison et al. disclose an instrument wherein the guide surface overlies at least one of the body and the dilator (see Fig. 1).

Art Unit: 3739

In regards to claim 8, Davison et al. disclose an instrument wherein the dilator includes an interior portion 74, the guide surface 80 including a surface deviation formed on the interior portion of said dilator (see Fig 1).

In regards to claim 9, Davison et al. disclose an instrument wherein said leaf is metallic (see Col. 2, Lines 55-57).

In regards to claim 10, Davison et al. disclose an instrument wherein said leaf is biased at least in part towards the expanded position, as it is necessary to have an outerlayer to hold the dilator in a contracted condition (see Col. 4, Lines 3-12).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11-13 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent No. 6,800,084 to Davison et al. in view of U.S Patent No. 5,370,647 to Graber et al.

In regards to claims 11-13, Davison et al. disclose an instrument comprising: a body 12 having a leading end, a trailing end, and a lumen 16 between the leading and trailing ends; a mid-longitudinal axis passing through the lumen of the body; a dilator 40 at the leading end of the body being movable between an unexpanded position and an expanded position (see Figs. 1 and 2); and a retainer 100 adapted to retain the dilator 40 in the unexpanded position but is silent with respect to the retainer being attached to

Art Unit: 3739

a collar wherein the collar is movable relative to the body along the mid-longitudinal axis. However, Davison et al. teach that other suitable means for maintaining the dilator in a contracted position could be employed (see Col. 4, Lines 3-12). Graber et al. teach of an analogous device wherein a collar 611 and a retainer 610 are used to keep the dilator in a contracted state (see Fig. 17). It would have been obvious to one skilled in the art at the time the invention was made to attach use a collar and retainer in the apparatus of Davison as an alternate means for keeping the dilator in a contradicted state as taught by Graber et al.

Allowable Subject Matter

Claims 3-7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

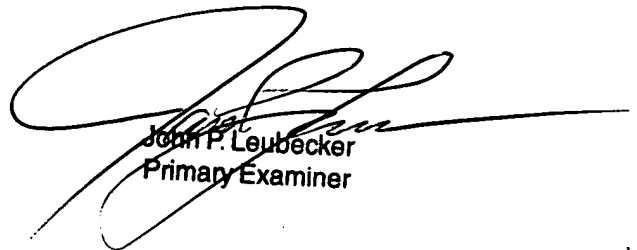
Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJK



3/29/05



John P. Leubecker
Primary Examiner